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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,545	02/15/2007	Hannu Pirila	944-003.183-1	8661

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EXAMINER

JAMA, ISAAK R

ART UNIT	PAPER NUMBER
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2617

MAIL DATE	DELIVERY MODE
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03/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/563,545

Applicant(s)

PIRILA ET AL.

Examiner

ISAAK R. JAMA

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/30/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 0205 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date See Continuation Sheet

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :12/30/200; 05/04/2007; 06/22/2007.

DETAILED ACTION

Claim Objections

1. Claims 1, 6 and 12 are objected to because of the following informalities: Claims 1, 6 and 12 recite "...network device supporting/operating the first mode....". The underlined lacks antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,125,283 (Kolev et al.) in view of The Instant Application's Admitted Prior Art.
3. Regarding claims 1, 6, 9, 12, 15, 18 and 20-22, Kolev teaches a method, system and apparatus for use in a network device, comprising the steps of: the network device supporting a first mode [Figure 4, Column 5, lines 16-17], receiving service request signaling from a multimode terminal for requesting any service [Column 2, lines 53-56; i.e. subscriber identity may be verified on network request] but which is not supported by the receiving network device or by the multimode terminal in the serving mode, characterized in that the network device is a network element of the multimode network [Column 2, lines 53-56; i.e. subscriber identity may be verified on network

request during mobile terminal network accesses and approved or rejected as a result of this process]. But Kolev does not specifically teach that the terminal supports in at least one of the various modes supported by the terminal. The Instant Application's Admitted Prior Art teaches that currently the terminal already provides some information about its capability in different system modes **[Page 1, paragraph 0004]**. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the information of The Instant Application's Admitted Prior Art in the terminal, system and method of Kolev in order for the network to ascertain requested services by the subscriber.

4. Regarding claims 2, 7, 13 and 16, Kolev teaches a method, system and apparatus where the network device decides to move the terminal to another system, supporting a second mode and the requested service, the second mode and the requested service in the second mode also being supported by the multimode terminal, if possible and necessary in order to establish the requested service **[Column 3, lines 27-31; i.e. operations of the mobile terminal of the present invention may be supported by service level information on various communication networks contained in memory within the mobile terminal or be obtained by the mobile terminal from the networks]**.

5. Regarding claims 4, 5, 10 and 11, Kolev teaches a method, system and apparatus where the service request signaling is triggered by a mobile station or a network originated service establishment request **[Figure 6B, steps 112, 120, 122 and 124]**.

6. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,125,283 (Kolev et al.) in view of The Instant Application's Admitted Prior Art and further in view of U.S. Patent Number 5,594,782 (Zicker et al.)

7. Regarding claims 3, 8, 14, 17 and 19, Kolev and The Instant Application's Admitted Prior Art has been discussed above. But neither Kolev nor The Instant Application's Admitted Prior Art specifically teach a method, system and apparatus where that the network device is using service request signaling messages that as such are used for services supported in the first mode, but using signaling parameter code points indicating a specific service that is not supported by the network device or by the multimode terminal in the first mode but the specific service being supported by another system operating in the second mode. Zicker teaches a multiple mode personal wireless communication system **[Title]** whereby a cell site is configured to continuously broadcast data which identify said cell sites, comparing in one of said radio handsets, said data which identify said cell sites with a preselected profile of cell site identity data, generating a trigger signal in response to a match of said data, transmitting an access request signal from said one radio handset in response to said trigger signal, said access request signal being configured to be received by one of said cordless stations **[Column 52, claim 1]**, and where the process further comprises the step of refraining from transmitting said access request signal when said trigger signal is absent **[Column 53, claim 8]**. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the system of Zicker in the in the

terminal, system, method and apparatus of Kolev and The Instant Application's Admitted Prior Art in order for the network to effectively control access operation.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent Number 6,748,246 (Khullar) teaches a method and apparatus for selecting an access technology in a multi-mode terminal. U. S. Patent Application Publication Number 2003/0114158 (Soderbacka et al.) teaches a method for performing an intersystem handover of a mobile terminal accessing a communication network via a radio access network of a first type.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ISAAK R. JAMA whose telephone number is (571)270-5887. The examiner can normally be reached on 7:30 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/IRJ/

/Lester Kincaid/

Supervisory Patent Examiner, Art Unit 2617